UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,748	09/28/2001	Shinichi Kawai	P20873	2169

7055	7590	03/14/2005	EXAMINER

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ART UNIT	PAPER NUMBER
2626	

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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/964,748	KAWAI, SHINICHI
	Examiner	Art Unit	
	Beniyam Menberu	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>28 September 2001</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-9</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-9</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>28 September 2001</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>12/18/2001</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Specification

1.   The disclosure is objected to because of the following informalities:

On page 13, lines 13-14, a hyphen is missing between the last word on line 13

"in" and first word of line 14 "stead".

On page 14, line 8, "the use name" should be "the user name".

Appropriate correction is required.

Drawings

2.   The drawings are objected to because in Figure 1, the Printer and Scanner are

not labeled by a reference number. In Figure 2, reference 203 should be named

"Domain Name Registration Area". In Figure 5, reference step ST506, the word

"Desination" should be "Destination". In Figure 7, ST703 the word "Succeedry" shoud be

"Succeeding" and in ST709 "atend" should be "at the end". Corrected drawing sheets in

compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid

abandonment of the application. Any amended replacement drawing sheet should

include all of the figures appearing on the immediate prior version of the sheet, even if

only one figure is being amended. The figure or figure number of an amended drawing

should not be labeled as "amended." If a drawing figure is to be canceled, the

appropriate figure must be removed from the replacement sheet, and where necessary,

the remaining figures must be renumbered and appropriate changes made to the brief

description of the several views of the drawings for consistency. Additional replacement

sheets may be necessary to show the renumbering of the remaining figures. Each

drawing sheet submitted after the filing date of an application must be labeled in the top

margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If

the changes are not accepted by the examiner, the applicant will be notified and

informed of any required corrective action in the next Office action. The objection to the

drawings will not be held in abeyance.

3.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5)

because they include the following reference character(s) not mentioned in the

description: ST516 in Figure 5. Corrected drawing sheets in compliance with 37 CFR

1.121(d), or amendment to the specification to add the reference character(s) in the

description in compliance with 37 CFR 1.121(b) are required in reply to the Office action

to avoid abandonment of the application. Any amended replacement drawing sheet

should include all of the figures appearing on the immediate prior version of the sheet,

even if only one figure is being amended. Each drawing sheet submitted after the filing

date of an application must be labeled in the top margin as either "Replacement Sheet"

or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the

examiner, the applicant will be notified and informed of any required corrective action in

the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 6167469 to Safai et al in view of U.S. Patent No. 6813036 to Matsushita.

        Regarding claim 1, Safai et al disclose a data communication apparatus that

transmits data (column 4, lines 65-67) to an input e-mail address via internet (column 8,

lines 61-65), comprising:

a first input section that inputs at least one character as a character string (column 9,

lines 15-21);

a first registration section that pre-registers a destination (column 9, lines 15-18);

a display section that displays input information from the first and second input sections

(column 9, lines 22-24);

a retrieving section that retrieves the destination from the first registration section using

the character string input by the first input section (column 9, lines 19-24); and

a controller that simultaneously displays the input information and the destination

retrieved by the retrieving section on the display section (column 9, lines 2-4, lines 20-

24);

and a second input section that inputs an @ mark (Figure 4b, reference 416 "@" key;

column 8, lines 49-64). However Safai et al does not disclose a data communication

apparatus that when an @ mark is input from the second input section, displays the

domain name read from the second registration section on the display section and a

second registration section that pre-registers a domain name.

Matsushita discloses a data communication apparatus that when an @ mark is

input from the second input section, displays the domain name read from the second

registration section on the display section (column 5, lines 4-26), and a second

registration section that pre-registers a domain name (column 4, lines 12-15).

Safai and Matsushita are combinable because they are in the similar problem

area of electronic data transmission.

At the time of the invention, it would have been obvious to a person of ordinary

skill in the art to combine the domain searching and displaying apparatus of Matsushita

with the system of Safai to implement a fast and accurate electronic data transmission.

The motivation to combine the reference is clear because Matsushita teaches

that the system provides for error free method for transmitting data over the internet

(column 1, lines 40-44).

6.   Claims 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over

U.S. Patent No. 6813036 to Matsushita in view of U.S. Patent No. 6829607 to Tafoya et

al.

Regarding claim 2, Matsushita discloses a data communication apparatus that

transmits data to an input e-mail address via internet (column 3, lines 59-62),

comprising:

a first input section that inputs at least one character as a character string (column 4,

lines 42-46);

a second input section that inputs an @ mark (column 5, lines 6-9);

a first registration section that pre-registers a destination (column 7, lines 56-60);

a second registration section that pre-registers a domain name (column 4, lines 12-15);

when an @ mark is input from the second input section, reads the domain name from the second registration section, and displays the read domain name on the display (column 5, lines 4-26). However Matsushita does not disclose a retrieving section that retrieves the destination from the first registration section using the character string input by the first input section; a display section that displays the input information from the first and second input sections and includes a first display and a second display adjacent to each other; a controller that simultaneously displays the input information on the first display of the display section and the destination retrieved by the retrieving section on the second display, when an @ mark is input from the second input section the read domain name on the second display.

Tafoya et al disclose a retrieving section that retrieves the destination from the first registration section using the character string input by the first input section (column 13, lines 39-49; Figure 6, reference 612, 610); a display section that displays the input information from the first and second input sections and includes a first display and a second display adjacent to each other (column 13, lines 39-49; Figure 6, reference 612, 610); a controller that simultaneously displays the input information on the first display of the display section and the destination retrieved by the retrieving section on the second display (column 13, lines 39-49; Figure 6, reference 612, 610).

Matsushita and Tafoya et al are combinable because they are in the similar problem area of electronic data transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the dual displaying system of Tafoya et al with the electronic data transmission system of Matsushita to implement an effective method of data transmission.

The motivation to combine the reference is clear because it is convenient to provide user with multiple visual display during data transmission.

Regarding claim 5, Matsushita in view of Tafoya et al teach all the limitations of claim 2. Further Matsushita discloses the data communication apparatus according to claim 2, wherein, when the desired domain name is selected by the selection section (column 8, lines 60-67; column 9, lines 1-10; Matsushita teaches that the facsimile machine displays the corresponding domain that was chosen. He further teaches that the input characters and the domain names are both displayed implying that there are multiple displaying system (column 6, lines 16-20).), the controller clears currently displayed information and displays the domain name read from the second registration section on the second display.

7.   Claim 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6167469 to Safai et al in view of U.S. Patent No. 6813036 to Matsushita further in view of U.S. Patent No. 6829607 to Tafoya et al.

Regarding claim 3, Safai et al in view of Matsushita teach all the limitations of

claim 1. Further Matsushita disclose the data communication apparatus according to

claim 1, further comprising: a selection section that selects a desired domain name from

the domain name displayed by the display section (Matsushita: column 5, lines 48-51,

lines 56-61). However Safai et al in view of Matsushita does not disclose data

communication apparatus wherein, when the desired domain name is selected by the

selection section, the controller concatenates the desired domain name and the

character string input by the first input section and displays the concatenated domain

name and the character string on the display section.

Tafoya et al disclose data communication apparatus wherein, when the desired

domain name is selected by the selection section, the controller concatenates the

desired domain name and the character string input by the first input section and

displays the concatenated domain name and the character string on the display section

(Tafoya et al discloses autofill for email address as shown in Table 1 (column 14, lines

35). Thus when typing email address and the current character is "@" symbol, possible

domain will show up (column 14, lines 6-10). Thus the selected address with character

string and domain as shown in Figure 6 will be displayed (Figure 6, reference 610).).

Safai et al, Matsushita, and Tafoya et al are combinable because they are in the

similar problem area of electronic data transmission.

At the time of the invention, it would have been obvious to a person of ordinary

skill in the art to combine email address concatenation system of Tafoya et al with the

system of Safai et al in view of Matsushita to implement an efficient system of electronic

data transmission.

The motivation to combine the reference is clear because the system of Tafoya

et al reduces the work needed by a user of the system when transmitting data over the

internet.

Regarding claim 4, Safai et al in view of Matsushita further in view of Tafoya et

al teach all the limitations of claim 3. Further Tafoya et al discloses the data

communication apparatus according to claim 3, wherein, when the selection section is

operated after the desired domain name is selected by the selection section, the

controller displays again the domain name read from the second registration section

(Tafoya et al discloses a method for displaying pop-up menu when user enters

characters of address. The pop-up menu shows possible domain names when the user

enters the "@" symbol. In table 2 (column 15, line 20) Tafoya et al disclose the

operation of different keys during the typing of characters. Using the escape key the

user can turn on or off the pop-up menu thus capable of displaying the domain names

even after user accepts the text.).

8.   Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over

U.S. Patent No. 6167469 to Safai et al in view of U.S. Patent No. 6813036 to

Matsushita further in view of U.S. Patent No. 6545768 to Matsubara et al.

Regarding claims 6 and 7, Safai et al in view of Matsushita teach all the

limitations of claim 1. However Safai et al in view of Matsushita does not disclose a one-

touch key or speed dial which provides an e-mail address corresponding to the input

one-touch key or speed dial.

Matsubara et al disclose a one-touch key/speed dial which provides an e-mail

address corresponding to the input one-touch key or speed dial (column 6, lines 38-45).

Safai et al, Matsushita, and Matsubara et al are combinable because they are in

the similar problem area of electronic data transmission.

At the time of the invention, it would have been obvious to a person of ordinary

skill in the art to combine one-touch/speed dialing system of Matsubara et al with the

system of Safai et al in view of Matsushita to implement a fast method for data

transmission.

The motivation to combine the reference is clear because one-touch/speed

dialing will reduce time needed for data transmission.

9.   Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 6167469 to Safai et al in view of U.S. Patent No. 6813036 to Matsushita.

Regarding claim 8, Safai et al disclose a data communication apparatus that

transmits data to an input e-mail address via internet (column 4, lines 65-67),

comprising:

a first input section that inputs at least one character as a character string(column 9,

lines 15-21);

a second input section that inputs an @ mark (Figure 4b, reference 416 "@" key;

column 8, lines 49-64);

a first registration section that pre-registers a destination in association with a key

(column 9, lines 15-18; column 8, lines 54-59);

a display section that displays input information from the first and second input

sections (column 9, lines 22-24). However Safai et al does not disclose

a second registration section that pre-registers at least one domain name;

a selection section that selects a desired domain name from the second registration

section; and a controller that reads a domain name from the second registration section,

and displays the read domain name with the input information on the display section,

the controller determining, when a desired domain name is selected by the selection

section, whether there is an @ mark in the input information, the controller

concatenating, when there is an @ mark, the input information and the desired domain

name and registering the concatenated input information and the desired domain name

in the first registration section.

Matsushita discloses a second registration section that pre-registers at least

one domain name (column 4, lines 12-15); a selection section that selects a desired

domain name from the second registration section (column 5, lines 56-60); and a

controller that reads a domain name from the second registration section, and displays

the read domain name with the input information on the display section (column 5, lines

50-56), the controller determining, when a desired domain name is selected by the

selection section, whether there is an @ mark in the input information (column 5, lines

5-8), the controller concatenating, when there is an @ mark, the input information and

the desired domain name (column 5, lines 59-63) and registering the concatenated

input information and the desired domain name in the first registration section (column

7, lines 55-60).

Safai et al and Matsushita are combinable because they are in the similar

problem area of electronic data transmission.

At the time of the invention, it would have been obvious to a person of ordinary

skill in the art to combine the domain selection and address generation of Matsushita

with the sytem of Safai et al to implement a fast and effective electronic data

transmission.

The motivation to combine the reference is clear because the system of

Matsushita reduces the work of a user that transmits data over the internet.

10.   Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 6167469 to Safai et al in view of U.S. Patent No. 6813036 to Matsushita

further in view of U.S. Patent No.6829607 to Tafoya et al.

Regarding claim 9, Safai et al disclose a data communication apparatus that

transmits data to an input e-mail address via internet (column 4, lines 65-67),

comprising:

a first input section that inputs at least one character as a character string(column 9,

lines 15-21);

a second input section that inputs an @ mark(Figure 4b, reference 416 "@" key; column

8, lines 49-64);

a first registration section that pre-registers a destination in association with a key

(column 9, lines 15-18; column 8, lines 54-59);

a display section that displays input information from the first and second input

sections (column 9, lines 22-24). However Safai et al does not disclose

a second registration section that pre-registers at least one domain name;

a selection section that selects a desired domain name from the second registration

section; and a controller that reads a domain name from the second registration section,

and displays the read domain name with the input information on the display section,

the controller determining, when a desired domain name is selected by the selection

section, whether there is an @ mark in the input information, the controller

concatenating, when there is not an @ mark, to generate the destination, the input

information and the desired domain name by inserting an @ mark there between, and

registering the generated destination in the first registration section.

Matsushita discloses a second registration section that pre-registers at least

one domain name (column 4, lines 12-15); a selection section that selects a desired

domain name from the second registration section (column 5, lines 56-60); and a

controller that reads a domain name from the second registration section, and displays

the read domain name with the input information on the display section (column 5, lines

50-56), the controller determining, when a desired domain name is selected by the

selection section, whether there is an @ mark in the input information (column 5, lines

5-8). However Matsushita does not disclose the controller concatenating, when there is

not an @ mark, to generate the destination, the input information and the desired

domain name by inserting an @ mark there between, and registering the generated

destination in the first registration section.

Tafoya et al discloses the controller concatenating, when there is not an @ mark, to generate the destination, the input information and the desired domain name by inserting an @ mark there between, and registering the generated destination in the first registration section (Tafoya et al disclose that the matching entries are displayed matching every letter until the current one that is inputted. Thus if the user enters the last letter before the "@" symbol, the system will display the complete email address with the @ symbol using the autofill option. Thus the system will display the "@" symbol and the rest of the address (column 14, lines 3-10; column 6, lines 55-63).).

Safai et al, Matsushita, and Tafoya et al are combinable because they are in the similar problem area of electronic data transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the domain selection of Matsushita and the address generation of Tafoya et al with the system of Safai et al to implement an accurate and efficient electronic data transmission.

The motivation to combine the reference is clear because the system of Matsushita and Tafoya et al will reduce the transmission time for electronic data by making it easier for user to input the email address.

Other Prior Art Cited

1.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6801546 to Yoshida et al disclose method for setting

destination and communication apparatus.

U.S. Patent No. 6028982 to Toyoda et al disclose facsimile apparatus with

email capabilities.

U.S. Patent No. 5812278 to Toyoda et al disclose facsimile apparatus with

email capabilities.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Beniyam Menberu whose telephone number is (703)

306-3441. The examiner can normally be reached on 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kimberly Williams can be reached on (703) 305-4863. The fax phone

number for the organization where this application or proceeding is assigned is 703-

872-9306.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the customer service office whose telephone number

is (703) 306-5631. The group receptionist number for TC 2600 is (703) 305-4700.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov/>.

Should you have questions on access to the Private PAIR system, contact the

Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner

Beniyam Menberu

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03/5/2005

MARK WALLERSON
PRIMARY EXAMINER